Remarks:

Regarding the provisional "obviousness type" double-patenting rejection in view of copending application US Serial No. 10/595767:

The applicant traverses the Examiner's present requirement and the "double patenting" rejection as being untimely and thus inappropriate.

No claims in the present application have been deemed to be allowable, and it is noted that, to date, no claims in the 10/597767 application have also been deemed allowable. Thus it is believed that the Examiner's requirement is both premature and inequitable to insist upon the entry of a Terminal Disclaimer at the present date which would unfairly compromise the applicant's potential interest in scope of patent protection in both of the applicant's currently co-pending applications. Upon indication of allowable subject matter in either application, the applicant will be in a better position to comply with the mandates of MPEP § 822 and requests that the Examiner reinstate the present rejection at such later date, should the basis for such a rejection be considered appropriate.

Regarding the rejection of claims 1, 4-8, and 13-17 under 35 USC 102(b) in view of GB 2367243, (hereinafter simply the "GB243" reference):

The applicant traverses the Examiner's rejection of the indicated claims as allegedly being anticipated by the GB243 reference.

Prior to discussing the relative merits of the Examiner's rejection, Applicants point out that "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). Further, anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must **necessarily** be present in the

invention described by the count, and it must be **so recognized** by persons of ordinary skill in the art"); [emphasis added] *In re Robertson,* 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "**could**" operate as claimed does not establish inherency); [emphasis added] *W.L. Gore v. Garlock, Inc.,* 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on **mere conjecture** respecting the characteristics of products that might result from the practice of processes disclosed in references"); [emphasis added] *In re Oelrich,* 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

At page 2 thereof, GB243 cites the following as the gist of its invention:

> We have now discovered that the house dust mite Der-p allergen can be denatured by burning candles containing certain natural oils to deactivate the allergens.
>
> Accordingly, the present invention provides a method for deactivating a Der-p allergen which comprises burning in a space to be treated a candle comprising a deactivating amount of a volatile oil selected from cajeput oil (tea tree oil) or an oil comprising one or more monocyclic terpene hydrocarbons.

The applicant traverses the Examiner's rejection of the claims, as the disclosure of GB243 fails to disclose the subject matter of the claims. The GB243 reference is wholly silent as to any long term effects of the use of its compositions and processes. The Examiner has failed to provide any documentation or other showing to support the Examiner's presupposition that the claimed properties would be inherent or would be both recognized and understood by a skilled artisan. The Examiner has failed to meet their burden of proof. A rejection under 35 USC 102(b) cannot be based on a presumption or conjecture. See *Hitzeman v. Rutter,* 243 F.3d 1345, 1355 [58 USPQ2d

1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property **must necessarily** be present in the invention described by the count, and it **must be so recognized** by persons of ordinary skill in the art") [emphasis added]; *In re Robertson,* 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

It is the applicant's position that, viewing the two "examples" of GB243 that a skilled artisan, at best, could reasonably conclude that the reduction in allergens occur (a) during the burning of a candle in a closed room, and (b) for up to 17 hours after permitting the candle to burn for 5 hours (see page 7 of GB243). However, it is the applicant's position that while the latter of the two experiments might reasonably suggest to a skilled artisan that the dust allergen reduction benefit may extend for a reasonable period, at best, a few hours beyond 17 hours following a 5 hour time of candle burn and release into the airspace, it would be unreasonable to expect that any such benefit could be expected at 14 days and 21 days following the release of the essential oils by a candle into the airspace. This result is wholly unexpected and beyond the realm of what a skilled artisan considering GB243 would expect. The difference between, at most several additional hours of additional benefit falls far short of, the 14 and 21 days which are claimed by the present applicant. It would be additionally unexpected that the allergen control benefit would be at least as good at 14 days or even at 21 days following the initial release of the allergen-deactivating compound, following that initial release. It is the applicant's position that this too is wholly unexpected and beyond the realm of what a skilled artisan considering GB243 would expect.

Accordingly, reconsideration of and withdrawal of the current rejection of the claims is solicited.

Regarding the rejection of claims 1. 4-8, and 13-17 under 35 USC 102(b) in view of WO 01/76371 (hereinafter referred to as "WO371"):

The applicant respectfully traverses the Examiner's rejection of the indicated claims in view of the WO371 reference.

The applicant traverses the Examiner's rejection of the claims, as the disclosure of WO371 fails to disclose the subject matter of the claims. The disclosure of the WO371 reference is similar to that of the prior GB243 reference. The gist of the WO371 document is found at the following passages from pages 2 and 3:

> We have now discovered a group of novel allergen denaturants for the house dust mite Der-p allergen which are derived from natural oils and can be delivered as a vapour to deactivate the allergens.
>
> Accordingly, the present invention provides a method of deactivating a Der-p and/or Der-f allergen which comprises volatilizing into a space to be treated a deactivating amount of a volatile oil selected from cajeput oil (tea tree oil) or an oil comprising one or more terpene hydrocarbons.
>
> The volatile oil may be volatilised by the use of heat to vaporize the oil. For example the volatile oil may be floated on water in an oil burner or heated directly in an oil burner. Alternatively the volatile oil may be vaporized from a heated wick dipped into a reservoir of the volatile oil.

Another method of volatilizing the volatile oil is from an ultra-sonic jet nebuliser which contains water with the volatile oil floated on the surface of the water.

A further method of volatilizing the volatile oil is by the ventilation of a source of the volatile oil using an ion wind. An ion wind generates an ionized air flow which facilitates the evaporation and dispersal of the volatile oil into the air. A unipolar charge is transferred to the molecules of the oil which is evaporated. Optionally the source of the

However, as in the prior GB243 reference, the WO371 reference is wholly silent as to any long term effects of the use of its compositions and processes.

The applicant traverses the Examiner's rejection of the claims, as the disclosure of WO371 fails to disclose the subject matter of the claims. The WO371 reference is wholly silent as to any long term effects of the use of its compositions and processes. The Examiner has failed to provide any documentation or other showing to support the Examiner's presupposition that the claimed properties would be inherent or would be both recognized and understood by a skilled artisan. The Examiner has failed to meet their burden of proof. A rejection under 35 USC 102(b) cannot be based on a presumption or conjecture. See *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property **must necessarily** be present in the invention described by the count, and it **must be so recognized** by persons of ordinary skill in the art") [emphasis added]; *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

It is the applicant's position that, viewing the two "examples" of WO371 that a skilled artisan, at best, could reasonably conclude that the reduction in allergens occur (a) during the burning of a candle in a closed room, and (b) for up to 16 hours after permitting the candle to burn for 5 hours (e.g., see 'Example 4', at page 12, and 'Example 5', at page 13 of WO371). However, it is the applicant's position that while the latter of the two experiments might reasonably suggest to a skilled artisan that the dust allergen reduction benefit may extend for a reasonable period, at best, a few hours beyond 16 - 17 hours following a 5 hour time of candle burn and release into the airspace, it would be unreasonable to expect that any such benefit could be expected at 14 days and 21 days following the release of the essential oils by a candle into the airspace. This result is wholly unexpected and beyond the realm of what a skilled artisan considering WO371 would expect. The difference between, at most several additional hours of additional benefit falls far short of, the 14 and 21 days which are claimed by the present applicant. It would be additionally unexpected that the allergen control benefit would be at least as good at 14 days or even at 21 days following the initial release of the allergen-deactivating compound. It is the applicant's position that this too is wholly unexpected and beyond the realm of what a skilled artisan considering WO371 would expect.

Accordingly, reconsideration of and withdrawal of the current rejection of the claims is solicited.

Regarding the rejection of claims 1, 9, 11 and 18 under 35 USC 103(a) in view of GB 2367243 (the "GB243" reference), or WO 01/76371 (the "WO371" reference) each in view of WO 03/070286 (hereinafter referred to as the "WO286" reference):

The applicant traverses the rejection of the indicated claims in view of the GB243 reference in view of the WO286 reference. The applicant also traverses the rejection of the indicated claims in view of the WO371 reference in view of the WO286 reference.

For the sake of brevity the applicant herein repeats and incorporates by reference the foregoing remarks concerning the GB243 reference, and the WO371 reference in being

similarly applicable to the current rejection entered under 35 USC 103(a). It is the applicant's view that the additional consideration of WO286 with either the GB243 reference, or in view of the WO371 reference does not overcome the inherent shortcomings of those documents, or render the presently claimed invention as being obvious.

Turning to WO286, although that reference may suggest the utility of certain terpenes in controlling respiratory infection, particularly when such are applied to a surface, the Examiner's proposed combination of WO286 with GB243 does not alter the fact that neither WO286 nor GB243 provides a reasonable basis for a skilled artisan to expect that a highly effective level of control of allergens would be realized either at 14 days, or 21 days following the initial release of the allergen-deactivating compound. This result is wholly unexpected and beyond the realm of what a skilled artisan considering WO286 with GB243 could and would reasonably expect. At best, combined consideration of WO286 with GB243 might suggest the utility of terpenes in candles of GB243; but the effects of the claimed invention could not be reasonably expected nor foreseen. Similarly, the Examiner's proposed combination of WO286 with WO371 does not alter the fact that neither WO286 nor WO371 provides a reasonable basis for a skilled artisan to expect that a highly effective level of control of allergens would be realized either at 14 days, or 21 days following the initial release of the allergen-deactivating compound. This result is wholly unexpected and beyond the realm of what a skilled artisan considering WO286 with WO371 could and would reasonably expect. At best, combined consideration of WO286 with WO371 might suggest the utility of terpenes in candles or compositions of WO371; but the effects of the claimed invention could not be reasonably expected nor foreseen.

Accordingly reconsideration of, and withdrawal of the outstanding rejection is solicited.

Regarding the rejection of claims 1, 10 - 11 and 19 under 35 USC 103(a) in view of GB 2367243 (the "GB243" reference), or WO 01/76371 (the "WO371" reference) each in view of US 6500445 to Pullen (hereinafter referred to as the "Pullen" reference):

The applicant traverses the rejection of the indicated claims in view of the GB243 reference in view of the Pullen reference. The applicant also traverses the rejection of the indicated claims in view of the WO371 reference in view of the Pullen reference.

For the sake of brevity the applicant herein repeats and incorporates by reference the foregoing remarks concerning the GB243 reference, and the WO371 reference in being similarly applicable to the current rejection entered under 35 USC 103(a). It is the applicant's view that the additional consideration of Pullen with either the GB243 reference, or in view of the WO371 reference does not overcome the inherent shortcomings of those documents, or render the presently claimed invention as being obvious.

Pullen's compositions are all liquid based compositions which contain at least one terpene and at least one surfactant, as Pullen summarizes:

SUMMARY OF THE INVENTION

The present invention relates to a non-toxic aqueous pesticide and method of application to effectively control dust mites found in clothing, pillows, bedding, furniture and rugs or carpets comprising at least one surfactant and at least one terpene containing oil.

These compositions are largely aqueous in nature. As to the mode of application of Pullen's compositions, these are recited by Pullen at col. 4 as:

> In use, the non-toxic aqueous pesticide is diluted with water and applied to the surface of the bedding, carpets, upholstery, pillows or the like, or used to launder or wash clothing, pillow slips and other fabric products. After the pesticide has been so applied or used, the pesticide residue is rinsed or removed. An effective dilution rate is from about 2 per cent to about 7 per cent but preferably 5 per cent by weight, i.e. 5 per cent composition is diluted with a balance of water by weight. In some cases, repeated applications may be required.

Thus, Pullen's mode of application can be distinguished from those of the GB243 reference, and the WO371 reference and at the outset, any combination with Pullen may be questioned as at no point does Pullen suggest that vaporization of his composition may have a benefit in controlling allergens.

However, even if Pullen were considered for its recitation of terpene oils, the combined consideration of Pullen with either of the GB243 reference, and the WO371 reference would not overcome the shortfalls of those documents, nor in any way render the applicant's presently claimed invention as being obvious. The Examiner's proposed combination of Pullen with GB243 does not alter the fact that neither Pullen nor GB243 provides a reasonable basis for a skilled artisan to expect that a highly effective level of control of allergens would be realized either at 14 days, or 21 days following the initial release of the allergen-deactivating compound. This result is wholly unexpected and beyond the realm of what a skilled artisan considering Pullen with GB243 could and would reasonably expect. At best, combined consideration of Pullen with GB243 might support the utility of terpenes in candles of GB243; but the effects of the claimed invention could not be reasonably expected nor foreseen. Similarly, the Examiner's proposed combination of Pullen with WO371 does not alter the fact that neither Pullen nor WO371 provides a reasonable basis for a skilled artisan to expect that a highly effective level of control of allergens would be realized either at 14 days, or 21 days following the initial release of the allergen-deactivating compound. This result is wholly unexpected and beyond the realm of what a skilled artisan considering Pullen with WO371 could and would reasonably expect. At best, combined consideration of Pullen

with WO371 might suggest the utility of terpenes in the candles or compositions of WO371; but the effects of the claimed invention could not be reasonably expected nor foreseen.

Accordingly reconsideration of, and withdrawal of the outstanding rejection is solicited.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

The early issuance of a *Notice of Allowability* is solicited.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, including any extension of time fees, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;

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19 August 2010
Date: